

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 23-26 and 36-51 are pending in this application. Claims 1-22 and 27-35 have been canceled without prejudice or disclaimer. Claims 23, 24, 36, 39, and 40 have been amended and new Claims 44-51 have been added to better highlight the manner of recording the overlapped partial images. Claims 25, 26, 37, 38, 42, and 43 have also been amended to correct typographical errors and to be consistent with the independent claim changes. All changes find clear support in the previously submitted claims and the elected embodiment so that there has been no introduction of new matter.

The outstanding Office Action presents an objection to Claim 42 and a rejection of Claims 23, 25, 26, 36-38, and 40-42 under 35 U.S.C. §103(a) as being unpatentable over Dunton et al. (U.S. Pat. No. 6,304,284, Dunton) taken in view of the “Official Notice” noted by the Examiner.

Initially, Applicants acknowledge with appreciation the indication that Claims 24, 39 and 43 are allowed.

Turning to the objection to Claim 42, it is noted that the present amendment corrects the dependency of this claim so it depends on method Claim 40 instead of apparatus Claim 36. Accordingly, it is respectfully submitted that this objection has been overcome and should be withdrawn.

The rejection of Claims 23, 25, 26, 36-38, and 40-42 under 35 U.S.C. §103(a) as being unpatentable over Dunton in view of Official Notice is traversed as to amended Claim 23 because Dunton has no reasonable teaching or suggestion of at least the Claim 23 subject matter requiring:

a recording unit configured to record a series of overlapped partial images selectively acquired by the first image pickup unit;

a second image pickup unit configured to continuously pick up a secondary image of the subject that corresponds with a portion of the subject is being scanned by the first pickup unit;

an overlapping amount calculating unit configured to calculate an amount of overlap between images corresponding to potentially recordable partial images being acquired by said first image pickup unit based upon the secondary image picked up by said second image pickup unit;

an image recording determination unit configured to output a recording indicating signal when a current image obtainable from the first image pickup unit is to be recorded as one of the series of overlapped partial images based upon the an amount of overlap calculated by the overlapping amount calculating unit; and

a control unit configured to be responsive to the recording indicating signal automatically cause the recording by the recording unit of the current image obtainable from the first image pickup unit recording unit.

Furthermore, and contrary to the assertion in the paragraph bridging pages 4 and 5 of the outstanding Action, there is no teaching of responding to a determination that a current partial image is to be recorded to automatically perform any recording that appears in FIG. 5 as to indicators 504 and 524; at col. 7, lines 56-57; at col. 8, lines 48-51, or at col. 4 lines 63-67. For example, while col. 4 lines 63-67, indicate that a picture is recorded when the camera is at a second position, there is no teaching or suggestion here that this recording is done “automatically.” The same lack of any disclosure of an “automatic” recording is true as to FIG. 5 indicators 504 and 524; col. 7, lines 56-57; and col. 8, lines 48-51. The PTO simply assumes the word “automatic” to be present as to various teachings that a camera makes a recording, but no such teaching that these recordings are made “automatically” is presented. Assumptions and speculation are not evidence and cannot be substituted for such required evidence. *See In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”) To the extent that the PTO is further expressing the view that the artisan could design and implement

a control arrangement to make these suggested recordings “automatically,” the above-noted *Mills* decision clearly requires the establishment of proper motivation to do this.

Furthermore, “Official Notice,” is not evidence placed in the record. It is widely held to be inappropriate to rely on Official Notice for the crux of a rejection instead of as a replacement for evidence of minor auxiliary matters. Here, Official Notice is improperly relied on to first create separate cameras dedicated to performing different multiple functions and then to add such camera to Dunton without properly establishing motivation to not only complicate the single camera of Dunton, but also to do it in a manner that requires this second camera to pickup an image and to use it to make the claimed calculation of the amount of overlap that is not taught by Dunton.

First, it is noted that the only function that applies to all cameras is that of recording a picture. As there are no different picture recording functions present or alleged, the simple question, unanswered in the rejection, is why the artisan would have been led to use two cameras when only one will do as clearly taught by Dunton.

From this unanswered question and undocumented conclusion lacking any evidence in the record, the outstanding Action jumps to a second conclusion that using a plurality of individual cameras is a “simplified design” some how easier to repair and trouble shoot as stated at page 7, lines 5-10. These undocumented conclusions that are being offered in place of the evidence required by the PTO reviewing Court is a clear violation of that precedent. In this last regard, the court in *In re Zurko*, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001) noted the following:

We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience — or on its

assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

An even more recent decision, *In re Lee*, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002) has emphasized the need for both examiners and the Board to provide evidence, not mere unsupported opinion, as follows:

In finding relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint [that of the person of ordinary skill in the art to which the subject matter pertains]. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record.

This prohibition as to using “Official Notice” in place of actual evidence in something other than a very minor “fill in the gaps” capacity was further emphasized as being improper in *In re Ahlert*, 165 USPQ 418, 421 (CCPA 1970):

Typically, it is found necessary to take notice of facts which may be used to supplement or clarify the teachings of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching. The facts so noted serve to 'fill in the gaps' which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. We know of no case in which facts judicially noted comprised the principle evidence upon which a rejection was based were of such importance as to constitute a new ground of rejection when combined with the other evidence previously used. [Emphasis added.]

Accordingly, it is again submitted to be clear that the outstanding Office Action improperly attempts to use “Official Notice” as a substitute for the required production of evidence as to a core factual finding.

Rather than explain why “Official Notice” can be properly used as a substitute for making a required showing based upon actual evidence of this core fact needed to establish obviousness, the outstanding Action attempts to once again avoid the case law and the limitations it places on the use of “Official Notice” fully acknowledged in the Summary of MPEP § 2144.03 as follows:

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421 [emphasis added].

To whatever extent that MPEP § 2144.03 requires a different traversal of the logical basis presented for properly taking "Official Notice," it can only be applicable when these prerequisites have been met in terms of the "Official Notice" being used to insubstantially fill in gaps, not as the core evidence being relied upon as Official Notice is prohibited as a substitute for actual core evidence as noted above.

In addition, in addressing the subject matter from Claim 25 at the bottom of page 7 of the outstanding action, the PTO acknowledges that Dunton does not teach this subject matter. The outstanding Action then attempts to modify the actual teaching at col. 8, lines 42-51, of Dunton, as to manual camera adjustments, as somehow suggesting the claimed stopping of "acquiring the partial images when an amount of shift of said first image pickup unit is greater than a desired value." However, teaching at col. 8, lines 42-51, concerns positioning the camera to acquire a recording, it in no way suggests or reasonably teaches the required stopping of "acquiring the partial images when an amount of shift of said first image pickup unit is greater than a desired value."

Independent Claims 36 and 40 clearly parallel independent Claim 23 and also have been amended to emphasize the manner of calculating overlap using each image from a different image source. Thus, independent Claims 23, 36, and 40 are all believed to clearly patentably define over Dunton with or without the improperly invoked "Official Notice." As Claims 26, 38, 41, and 42 all depend from one of these base independent claims, they are also

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believed to patentably define over Dunton and the improperly invoked "Official Notice" for the same reasons as their respective parent claims.

As the newly added Claims all depend from a claim argued above, these new claims are also believed to patentably define over Dunton and the improperly invoked "Official Notice" for the same reasons as their respective parent claims.

As no other issues are believed to remain outstanding relative to this application, it is believed to be clear that this application is in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

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